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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/908,966	07/19/2001	Christopher McCormick	ELT-002 (6281/6)	6828
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TESTA, HURWITZ & THIBEAULT, LLP HIGH STREET TOWER 125 HIGH STREET BOSTON, MA 02110			EXAMINER SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/908,966

Applicant(s)

MCCORMICK ET AL.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 103103. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the method steps encompassed by the phrase “wherein the step of assigning one of the authorized teachers to one of the students includes selecting that one teacher from a list of teachers by an administrator” renders the claim indefinite. The claim is dependent from independent claim 1 which encompasses an embodiment of the applicants claimed invention directed to a teacher selecting a student, however claim 3 is directed to a different embodiment in which an administrator matches the student and teacher. Thus the applicant appears to be inappropriately combining two different embodiments where it is unclear who is actually matching the student and teacher (i.e. is it the administrator or the teacher?).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In analyzing claims 1, 3-12 for patent eligible subject matter, it is useful to first answer the question "What did applicant[s] invent?" In re Abele, 214 USPQ 682 (CCPA 1982). The preamble of claim 1 characterizes the invention as a "method for facilitating private instruction over a network between a teacher and student . . .", Thus the invention is essentially a species of what teachers and students have done for ages – communicate to match their needs and schedules. Stated differently the invention takes old and conventional matching of students and instructors/tutors/teachers and performs that old process over a network (i.e. internet).

Having determined in general what the invention is, we must analyze it under the prevailing case law. The statute itself allows for the patenting of processes. However, it has been determined in many contexts that not all processes set forth patent eligible subject matter. One test that has recently been applied is whether the invention produces a useful, concrete, tangible result. See e.g., States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance.

In this case, the claimed invention does not produce a "concrete" result in the sense that it cannot be reasonably assured that private instruction will be predictably enabled by the steps set forth. There is simply too much subjectivity involved because the process effectively relies on the state of mind of the participants rather than an

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objective standard. Actual matching of a teacher and student, much less actual private instruction, is completely up to the participants. The process itself is no more than an attempt and a hoped-for result.

The claimed invention does not produce a “tangible” result in the sense that it merely manipulates abstract ideas without producing a physical transformation or conversion of the subject matter expressed in the claim so as to produce a change of character or condition in some physical object. See In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994); In re Schrader, 30 USPQ2d 1445 (Fed. Cir. 1994). Except for the use of a network, the remaining steps of the claim are effectively no more than items of conversation that are deemed abstract in nature. Mindful of the need to focus on what the inventor did in fact invent, it is not a global network (merely a designated forum) or profile information stored therein (merely a recorded abstract idea). The method does not produce a physical transformation and yields no tangible result. It is thus effectively a manipulation of abstract ideas and is thus not statutory.

Even if it might be determined that the claimed method can be characterized as producing a useful, concrete, tangible result, to be proper subject matter for patent eligibility, any useful, concrete, tangible result must be within the useful or technological arts. See e.g., In re Musgrave, 167 USPQ 280 (CCPA 1970); In re Foster, 169 USPQ 99 (CCPA 1971). The Constitution empowers Congress to promote the useful arts. The term “useful arts” has been equated with “technological arts” in a number of decisions. See e.g., In re Waldbaum, 173 USPQ 430 (CCPA 1972).

In this case, the claimed invention is not within the useful or technological arts. Rather, the invention is within the realm of the liberal arts or social sciences. In Musgrave and Foster, the inventions were deemed to be within the technological arts. In those cases, each invention clearly involved computer or machine technology. But here, there is no technology involved at all. There is no technology disclosed or claimed. A global network is a peripheral element to the actual process and cannot reasonably convert an otherwise non-statutory process outside the technological arts into one that is in fact within the technological arts.

Claims 1, 3-12 do not produce a useful, concrete, tangible result in the technological arts. The invention as disclosed and claimed does not promote the progress of the useful arts. Accordingly claims 1, 3-12 do not define statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 5-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Chao et al '632. Chao discloses a method for facilitating private instruction over a

network containing all of the elements of the claims including with reference to claim 1, receiving student profile information from each student who registers for a private course (cols. 4-5, lines 61+ and 1-5), adding each student who registers for a private course to a list of students (read onto the list/database of students stored in the storage medium 108) are unassigned a teacher (col. 4, lines 5-10), enabling access to the list of students and the profile information of the students over the network by each teacher who is able to teach a course, wherein the teacher selects a student from the list of students after viewing the profile information (col. 2, lines 55-58), assigning one of the teachers to one of the students (col. 2, lines 55-58). The selection of a teacher from a list of teachers by an administrator, as required by claim 3, is described in col. 2, lines 58-60, where the automated apparatus is considered to be an administrator. An assigned teacher being in a different time zone than the student, as required by claim 5, is described in col. 2, lines 61-65. The step of communicating between the assigned teacher and the student to negotiate terms related to conducting the given private course, as required by claims 6 and 7, is described in col. 3, lines 3-5 and col. 6, lines 63-66. Student profile information identifying a time of day and week for conducting discussion sessions with the teacher, as required by claim 8, is described in col. Opening a voice and text channel, as required by claims 9 and 10 respectively, is described in cols. 6, lines 27-32 and col. 7, lines 1-13. A given private course being a course for teaching a language that is foreign to the student, as required by claim 11, where the language is English (as required by claim 12) is described in cols. 1 and 2, lines 34-48 and 61-65 respectively.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al '632. Chao lacks an explicit teaching of placing each student in the list of students in an order based upon an enrollment date of each student. However, the order of placement of a student on an enrollment list based upon the enrollment/registration date is well known in the educational arts (i.e. colleges class registration is completely based upon the enrollment date of a particular student). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to place a student on a registration list based upon an enrollment date for the purpose of providing a fair and honest service based on "first come, first serve methodology".

***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-12 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



DERRIS H. BANKS  
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